



MYERS BIGEL SIBLEY & SAJOVEC, P.A.

PATENT LAWYERS

D. Randal Ayers	Anna R. Carr ¹	Karen A. Magri, Ph.D.	Rohan G. Sabapathypillai
David D. Beatty	Robert N. Crouse	Robert M. Meeks	F. Michael Sajovec
Mitchell S. Bigel	Robert W. Glatz	Mary L. Miller, Ph.D.	Grant J. Scott
Needham J. Boddie, II	David C. Hall	D. Scott Moore	Kenneth D. Sibley
Alice M. Bonnen, Ph.D.	Scott C. Hatfield	James D. Myers	Elizabeth A. Stanek
Lynne A. Borchers	Laura M. Kelley	David K. Purks	Richard P. Vitek
James R. Cannon	Shawna C. Lemon, Ph.D.	Julie H. Richardson	

October 18, 2005

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Re: Misdirected Mail-Issue Notification
Patent Application Serial No. 10/791,542

Dear Sirs:

Regarding a telephone conversation with Examiner Marianne L. Padgett on Friday, October 14, 2005, enclosed is the Restriction Requirement for the above-referenced patent application. These papers were sent to us in error by the Patent Office. We are returning them to you per the instructions of Examiner Padgett whose telephone number is (571) 272-1425.

To acknowledge receipt of this communication and the enclosed Restriction Requirement, please sign the enclosed copy of this letter and return it to my attention in the envelope provided. If you have any questions or concerns, please do not hesitate to call.

Sincerely,

Phyllis M. Hines
Paralegal-Patent Administrator

PH:llh
Enclosures

ACKNOWLEDGMENT:

Signature: _____
Name: _____

Date

IFW

Art Unit: 1762

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-9 & 19-24, drawn to a process for coating a surface with lubricant, classified in class 427, subclass 384+ or 488+ or 525 or 535+ or 551.
 - II. Claims 10-18 & 25-31, drawn to a lubricant coated surface, classified in class 428, subclass 421 or 447.

2. The inventions are distinct, each from the other because:

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product can be made by many different processes, since its only necessary structure consists of a generic lubricant on a generic substrate, except in claims 13 or 29, where generic compound species are listed. As the energy exposure (before or after) has no necessary effect, processes that apply no energy could have identical results, which since unspecified, cannot be determined with any necessity. Note since all energy or even all plasma gases or all ionizing radiation will not effect all types of lubricants or all possible substrates (second series of each set of claims) in the same way, use of them can not be said to have any necessary effect, especially since the parameters employed (unspecified) may create significantly different effects on a single particular material.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Art Unit: 1762

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group II is not required for Group I, restriction for examination purposes as indicated is proper.

4. A telephone call was made to David Hendricks on 10/4/2005 to request an oral election to the above restriction requirement, but did not result in an election being made.

Mr. Hendricks return message requested mailing of the restriction at the request of applicants.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

6. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marianne L. Padgett whose telephone number is (571) 272-1425. The examiner can normally be reached on M-F from about 8:30 a.m. to 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks, can be reached at (571) 272-1423. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available

Application/Control Number: 10/791,542

Page 4

Art Unit: 1762

through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MLP 10/6/2005

A handwritten signature in black ink, appearing to read 'Marianne Padgett', written in a cursive style.

MARIANNE PADGETT
PRIMARY EXAMINER